



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.  | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------|------------------|
| 09/428,453  | 10/28/1999  | SATORU MOTOHASHI     | 35.C13980            | 4676             |
| 5514  | 7590        | 07/07/2004           | EXAMINER             |                  |
| FITZPATRICK CELLA HARPER & SCINTO<br>30 ROCKEFELLER PLAZA<br>NEW YORK, NY 10112 |             |                      | RODEE, CHRISTOPHER D |                  |
|   |             |                      | ART UNIT             | PAPER NUMBER     |
|   |             |                      | 1756                 |                  |

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                                  |  |
|------------------------------|-------------------------------|----------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>09/428,453 | Applicant(s)<br>MOTOHASHI ET AL. |  |
|                              | Examiner<br>Christopher RoDee | Art Unit<br>1756                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 15,22,26,27,29,30 and 33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15, 22, 26, 27, 29, 30, and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 May 2004 has been entered.

### ***Claim Rejections - 35 USC § 112***

Claims 15, 22, 26, 27, 29, 30, and 33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The instant claims have been amended to specify the photosensitive member's "second polycarbonate resin has a viscosity average molecular weight of 20,000 or more". Although the specification as filed does disclose the second polycarbonate as having a viscosity average molecular weight of 20,000, the specification only discloses this specific volume average molecular weight for the second polycarbonate. There is no basis for a value larger than 20,000. The specification states, "a ratio in the blend compound between the polycarbonate resin I and the polycarbonate resin II is preferably selected so that the polycarbonate resin I having viscosity average molecular weight of 15000 or less is included by 30 to 95 parts by weight with respect to the blend compound" (p. 13, l. 17-21). The specification also states, "In

Art Unit: 1756

the illustrated embodiment, the charge carrier transport layer 2d is constituted as follows. That is to say, 1. charge carrier transport material, 2. composition of polycarbonate resin I having viscosity average molecular weight of 5000 and polycarbonate resin II having viscosity average molecular weight of 20000 in which the polycarbonate resin I having viscosity average molecular weight of 5000 is included by 40 parts by weight, and 3. fluoroplastic particles are included by 2.0 parts by weight with respect to the total weight of material constituting the charge carrier transport layer 2d" (p. 11, l. 26 – p. 12, l. 10). The only disclosure of a viscosity average molecular weight for the polycarbonate II (i.e., the second polycarbonate) is 20,000.

In the recent traversal applicants refer to the passage on specification page 13, lines 2-16 for basis of the amendment, particularly with respect to the molecular weight reaching or exceeding a certain value. Applicants also note that the strength of the layer containing this molecular weight material is not further increased as the molecular weight is further increased. Applicants state, "It is apparent from the above-noted disclosures that the phrase the molecular weight reaches a certain value or exceeds the certain value means –the molecular weight reaches 20,000 or exceeds 20,000 –".

The Examiner has carefully considered applicants' remarks but cannot agree with this position. The passage referred to by applicants cautions the artisan that no benefit is obtained by increasing the molecular weight beyond a certain value. There is no indication that a viscosity average molecular weight of 20,000 is the "certain value". In fact, the specification appears to be teaching away from using a material above the "certain value" because there is no benefit disclosed or suggested. These passages fail to provide basis for the claims as now presented, and, in fact, appear to be teaching away from the claims as presented. New matter is present in the claims, and they are properly rejectable under this section of code.

Art Unit: 1756

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on most weekdays from 6:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**CHRISTOPHER RODEE  
PRIMARY EXAMINER**

cdr  
30 June 2004